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Patent
Attorney's Docket No. 018793-253

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	
)	
Takeya ABE et al.)	Group Art Unit: 1652
)	
Application No.: 09/936,514)	Examiner: Christian Fronda
)	
Filed: September 14, 2001)	Confirmation No.: 4410
)	
For: PROCESS FOR PURIFYING)	
AMIDE COMPOUND)	

RESPONSE TO RESTRICTION/UNITY OF INVENTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the restriction/unity of invention requirement set forth in the Official Action dated January 11, 2005, applicants hereby elect the subject matter of Group I which currently contains claims 4 and 7-16 and 19-24 (with linking claims 1-3, 17 and 18). This election is made with traverse for reasons similar to those provided in the response filed on October 26, 2004, in connection with the previous requirement set forth in the Official Action dated September 30, 2004.

In particular, the Examiner has again taken the position in the Action that the technical feature shared between the inventions of Group I and Group II is a process for purifying an amide-containing solution by contacting the solution with activated carbon. The Examiner has then alleged that Oriel et al., WO 99/55719, teaches this technical feature and has therefore concluded that unity of invention is lacking.

Applicants again respectfully note that the Examiner has failed to consider each and every element set forth in claim 1, which is required by long-standing decisions such as In re Boe and Duke, 184 USPQ 38 (CCPA 1974) where the court noted: "...all limitations must be considered and that it is error to ignore specific limitations distinguishing over the references." In this respect, applicants again point out that claim 1 does not merely recite a process wherein an amide-containing solution is contacted with activated carbon. Instead, the claim specifically recites that such contact is "under acidic conditions". This recitation is important in obtaining good recovery of the amide. As previously explained, the illustrative Examples and the Comparative Example set forth starting on page 18 of the specification demonstrate the importance of acidic conditions. As provided therein, when following the process as defined in claim 1, effective protein removal from the solution can be obtained under acidic conditions (99% or more in Example 1). However, as shown in Comparative Example 1 on page 31, when the pH is adjusted to pH 7, the removing rate was only 25%.

Oriel et al. does not teach this specific condition defined in claim 1 and certainly does not recognize the effect that the claimed acidic conditions have on the process. Therefore, claim 1 is patentable over this document and it also follows that the claims of record fully comply with the unity of invention provisions and should all be examined together. Accordingly, reconsideration and withdrawal of the restriction/unity of invention requirement and allowance of the present application are respectfully requested.

Should the Examiner wish to discuss any aspect of the present application,
the Examiner is invited to contact the undersigned attorney at the number provided
below.

Respectfully submitted,

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